

REMARKS

Claims 1-20 are still pending in this application. Reconsideration of the application is earnestly requested.

The Examiner has rejected claims 1-20 under section 103 as being unpatentable over *Tushie et al.* (*Tushie*) in view of *Morris*. Although the Examiner's arguments have been carefully considered, Applicant respectfully traverses these rejections as explained below.

The Cited Art Distinguished—*Tushie*

As a first step, claim 1 specifically requires

executing a personalization assistant software tool, said software tool including a default member profile having default values for smart card features.

As pointed out in the previous reply, the term "smart card features" has a particular meaning as explained in the specification. "Smart card features" referred to features of a smart card. A member profile is a profile of a particular member that has default values for these features. The cited portions of *Tushie* do not disclose "a smart card personalization software tool including a default member profile having default values for smart card features." The Office action apparently relies upon issuer format template data and the card framework template record as disclosing this step.

For example, column 2 of *Tushie* discloses issuer format template data. Column 17 makes clear that a data format template is used to translate data fields into an internal order. An example data format template record is shown in column 17 at line 30. As shown (and as explained later in that same column), the template record simply holds an internal label to show how to order cardholder data internally. It is not a profile of a particular member. It does not have default values for smart card features. It simply holds ordering information to rearrange cardholder data. Further, claim 1 specifically requires in a fifth step that the default member profile is modified based upon user input. The data format template record as shown in column 18 is never modified based upon user input. It has static values. If the Office action insists that the data format template record is a member profile, then there is a problem with that analogy because the fifth step of claim 1 requires that the default member profile is modified.

The same problem surfaces with an attempt to equate the card framework template record of column 18 with the default member profile of claim 1. The card framework template record describes the structure of the chip on the card and is referenced at various times during the smart card issuing process (column 18, first full paragraph). Claim 1 requires in a fifth step that this default member profile is modified based upon user responses to queries. There is no disclosure in *Tushie* that the card framework template record is ever modified based upon responses to user queries.

Therefore, it is respectfully submitted that this first step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office action.

Claim 1 requires as a second step

providing a user with a plurality of queries regarding said smart card features, said queries originating from said software tool.

The Office action alleges that *Tushie* discloses this step in column 6.

Column 6 of *Tushie* at lines 42-56 discloses that the card issuer management system 150 sends cardholder data to the smart card personalization system 100. The management system 150 also determines the type of card issue, the card applications to embed and which personalization equipment to use. But, in the first place, neither the management system nor the personalization system is providing a user with queries regarding smart card features. There is no disclosure in *Tushie* showing that a user is presented with a number of queries and is then given a choice to respond to those queries. The management system of *Tushie* is simply using the prior art that is described in the background of the instant application. In other words, a user using the management system must manually decide on various options and then program software. Claim 1 provides an automatic method of choosing smart card features in order to personalize a batch of smart cards.

In the second place, once the management system tells the personalization system which card to issue, which card application to embed and which personalization equipment to use, there is no opportunity for a user to change those settings. Claim 1 specifically requires that in a third step a user provides responses to queries, and in a fourth and fifth step those responses are matched with data values and the member profile is modified. Once the management system determines which card type to issue (for example) there is no opportunity for a user of the personalization system to change that particular option. By contrast, claim 1 specifically

requires that the default member profile is modified using information originating from user responses to queries regarding smart card features.

Therefore, it is respectfully submitted that this second step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office action.

Claim 1 requires as a third step

receiving from the user responses to the plurality of queries, said responses being received by said software tool.

The Office action alleges that *Tushie* discloses this step at 152, and at columns 6 and 7. But, numeral 152 is simply a database of cardholder data. This is static information that does not change (such as cardholder name and cardholder account number); a user is not responding to queries. Also cited is column 6 at lines 53-56. *Tushie* discloses that the personalization system can also receive data from a person inputting the data from a telephone keypad. In other words, cardholder data can be received via a telephone keypad. But, there is no disclosure that this person is responding to a plurality of queries concerning smart card features. In fact, the person is simply inputting static cardholder data that would not change. Claim 1 specifically requires that the responses to these queries are used in a fifth step to modify a member profile. Any cardholder data received does not change and is not used to modify other data in the system.

Also cited is column 7, lines 48-51. This portion also discloses that there are various ways of inputting cardholder data into the card issuer management system such as by a magnetic tape, floppy disk, telephone, *et cetera*. But, there is no disclosure that a user is inputting responses to a plurality of queries regarding smart card features. Someone might be inputting cardholder data, but cardholder data is not a response to a query regarding a smart card feature.

Therefore, it is respectfully submitted that this third step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office action.

Claim 1 requires as a fifth step

modifying said default member profile using said matched output data values.

As discussed above, *Tushie* does not disclose modifying a member profile using matched output data values that are derived from user responses to queries regarding smart card features. The Office action first alleges at page 3 that the card framework template record of *Tushie* is

analogous to the default member profile, but the Office action then alleges at page 4 that the default member profile is found in paragraph 98 of *Morris*. The Office action cannot rely upon two different references to show the same claim element in order to get around the requirement of the claim that that element must be changed. As discussed above, *Tushie* cannot disclose the default member profile because claim 1 specifically requires that it be changed in the above a fifth step. Such a change of a default member profile is not disclosed in either reference.

Therefore, it is respectfully submitted that this fifth step of claim 1 is not taught or suggested by *Tushie* as alleged in the Office action.

Claim 1 requires as a sixth step

generating a personalization data file from said default member profile and said output data values.

Morris does not disclose this step as alleged in the Office action. See discussion below.

The Cited Art Distinguished— *Morris*

Morris discloses a system for handling medical information to create a record for an injured person and relates to the medical records field. The disclosure of *Morris* includes a wireless handheld assistant designed to record the essential elements of a medical history and physical examination and then provide the medical analysis and decision support for first responders. (Paragraph 35.)

The field of the present invention is personalization of smart cards. It is hard to imagine two fields (the medical records field of *Morris* and the smart card personalization field of *Tushie*) that are more different or completely unrelated, other than the fact that both disclosures discuss computers and databases. *Morris* is not available as a reference because one skilled in the art of smart card personalization would have no reason to be aware of the medical records field. For that reason alone, it is requested that the rejection be withdrawn because *Morris* is absolutely non-analogous and there is no motivation for anyone to combine it with *Tushie*.

Secondly, all the steps of claim 1 that are alleged as being present in *Morris* are positively not there. *Morris* does not concern smart cards, does not discuss software or equipment for personalizing a smart card, let alone a technique of automating personalization of

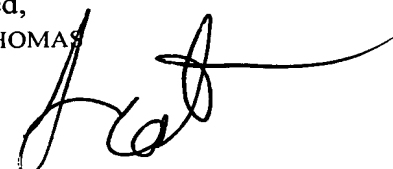
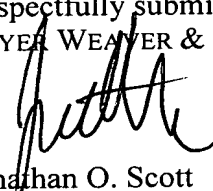
a smart card. The Office action appears to pick words or phrases from particular steps as being found in *Morris*. What is required, however, is that an entire step be disclosed in *Morris*, not particular random words of a step. For this reason as well, it is requested that the rejection of claim 1 be withdrawn.

Applicant will not spend time listing in detail why all of the alleged steps of claim 1 are not present in *Morris* as this would not be a good use of Applicant's time nor of the Examiner's time. Applicant also questions whether *Morris* is prior art based upon its filing date. The provisional application must contain all of the cited paragraphs otherwise *Morris* is not prior art.

Claim 11 requires many of the same similar steps as claim 1 and is believed patentable for the same reasons.

Reconsideration of this application and issuance of a Notice of Allowance at an early date are respectfully requested. If the Examiner believes a telephone conference would in any way expedite prosecution, please do not hesitate to telephone the undersigned at (612) 252-3330.

Respectfully submitted,
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